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55648 7590 09/09/2008 KEVIN L. RUSSELL CHERNOFF, VILHAUER, MCCLUNG & STENZEL LLP 1600 ODS TOWER 601 SW SECOND AVENUE PORTLAND, OR 97204				
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte M. IBRAHIM SEZAN, RICHARD QIAN, and
GEORGE BORDEN,

Appeal 2008-2196
Application 09/280,421
Technology Center 2600

Decided: September 9, 2008

Before MAHSHID D. SAADAT, JOHN A. JEFFERY, and KARL D.
EASTHOM, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1-8 and 10-30. Claim 9 has been cancelled, and remaining claims 31-117 have been withdrawn. (App. Br. 3). We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

STATEMENT OF THE CASE

Appellants' invention relates to a method and system for associating additional information with a video including a plurality of frames, wherein the additional information is related to at least one of the frames (Spec. 2).

Claim 1 is representative of the claims on appeal, and it reads as follows:

1. A method of associating additional information with a video including a plurality of frames comprising:

- (a) identifying at least one of said frames representative of a picture composed of a plurality of pixels;
- (b) providing a descriptive stream separate from said video;
- (c) including said additional information in said descriptive stream related to said at least one of said frames;
- (d) providing said video for displaying on a display;
- (e) selectively providing said additional information to a viewer approximately the time of said providing said video where said additional information is an object depicted by said picture by said pixels;
- (f) wherein said additional information includes executable computer program code.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Wistendahl

US 5,708,845

Jan. 13, 1998

Claims 1-8, 10-12, and 15-30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Wistendahl.¹

Claims 13-14 stand rejected under 35 U.S.C. § 103(a) based upon the teachings of Wistendahl and the Examiner's taking of Official Notice.

ISSUE

Appellants dispute the Examiner's determination that Wistendahl's N-data and IDM program code respectively meet "an object depicted by said picture by said pixels" and "wherein said additional information includes executable computer program code," as set forth *inter alia* in the method steps (e) and (f) of claim 1. (App. Br. 6). Independent product claim 21 recites similar limitations. Appellants do not present separate arguments to rebut the claim rejections. Thus, the issue before us is whether Wistendahl's N-data and IDM program code meet the disputed limitations of representative claim 1.

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir.

¹ The Examiner also inadvertently included cancelled claim 9 in this rejection. (Ans. 4).

1998)). During examination, the Examiner bears the initial burden of presenting a prima facie case. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984). Appellants may sustain their burden on appeal by showing that the prior art reference relied upon by the Examiner fails to disclose an element of the claim.

The Examiner's articulated reasoning in the rejection must possess a rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

ANALYSIS

Claims 1-8, 10-12, and 15-30

Turning first to the anticipation rejection, the Examiner asserts (Ans. 6) that Wistendahl's N-data constitutes the additional information set forth in step (e) of the claim; i.e., "said additional information is an object depicted by said picture by said pixels." We disagree.

The Examiner points to Wistendahl's hotspots, defined by the N-data, as depicted in the manner claimed. While we agree with the Examiner that such N-data maps a pixel area surrounding an object to create an outline of an area, i.e., a hotspot (Wistendahl, col. 6, ll. 4-8, *see also* Fig. 2 – hotspots

of rectangle A and circular area B; Ans. 12-13), we disagree that such N-data are depicted by pixels.

Rather, we agree with Appellants that the N-data is not a depicted object because it “is provided in a data stream separate from that of the video, [and] includes nothing more than frame and coordinate mapping information for hot-spots . . .” (Reply. Br. 4), and, as such, it is “transparent to the user” (App. Br. 5). In other words, Appellants contend that Wistendahl’s N-data itself is not a depicted object, but rather the N-data merely defines a depicted area.²

To counter this contention, the Examiner points to Appellants’ disclosure as supporting “additional information” that merely defines an object. (Ans. 11-12). While we agree that the disclosure supports a broader definition of “additional information,” the claim before us clearly calls for a more narrow construction that requires a depiction of the N-data itself; i.e., “said additional information is an object depicted by said picture by said pixels.”

As indicated above, Appellants similarly argue that Wistendahl’s asserted object, the N-data, is not executable code and that the IDM code is not depicted. In other words, Appellants’ argument boils down to an

² Appellants state: “The flaw in the Examiner’s rejection, however, is that neither the N-data nor the IDM program code are objects depicted by said picture.” (App. Br. 6).

assertion that the claim requires the object and the executable code to be one object depicted by pixels. (See Reply Br. 4).³

The Examiner does not directly address Appellants' argument that the claim requires that the object is executable code that is depicted by said picture by said pixels. Again, the Examiner focuses on Appellants' broad disclosure as supporting executable codes such as URL links (Ans. 13), and concludes that Wistendahl discloses similar code.

We also disagree with the Examiner's determination that the IDM program code constitutes the additional information as set forth in the claim. Rather, similar to our determination above, we determine that the claim before us is more limited than Appellants' broad disclosure of all of its embodiments, and, as such, requires that the "additional information is an object depicted by said picture by said pixels and . . . includes executable computer program code." (Emphasis added). While Wistendahl's IDM data may include executable code, the data is not depicted in the manner claimed, as Appellants argue, and, as the Examiner concedes by implication.

For the reasons noted above, the Examiner has failed to establish a prima facie case of anticipation for claims 1 and 21. Therefore, we will not sustain the Examiner's rejection of those claims. For the same reasons, we

³ Appellants state: "The Examiner's answer to appellant's brief glosses over the appellant's argument that the N-data, which the Examiner contents [sic] 'is' an object depicted by a picture on a computer monitor, does not include computer executable code." (Reply Br. 4). Appellants also state: "Hence, the N-data does not satisfy the limitations of claim 1 as the N-data does not include executable computer code. The IDM program similarly fails to satisfy the limitations of claim 1 as it is not 'an object depicted by said picture'." (Reply Br. 4).

also will not sustain the Examiner's rejection of dependent claims 2-8, 10-12, 15-20, and 22-30.

Claims 13-14

We also will not sustain the obviousness rejection of dependent claims 13-14 because the Examiner's taking of Official Notice addresses a separate issue, and accordingly, does not put forth any evidence and/or argument to overcome the deficiencies we found above with respect to Wistendahl. (*See* Ans. 10).

CONCLUSION

We reverse the Examiner's decision rejecting claims 1-8 and 10-30 on appeal.

REVERSED

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